

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

In re Patent application of:)
Richard E. Hunter et al.)
Serial No.: 09/846,994) Examiner: Davis D. Hwe
Filed: May 1, 2001) Group Art Unit: 3752
For: ***Rotor-Type Sprinkler with***
Turbine Over-Spin Prevention) Confirmation No.: 3915

REPLY BRIEF

BOARD OF PATENT APPEALS & INTERFERENCES
Director for Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Examiner's Answer dated March 28, 2007, the following additional argument is submitted.

In the Examiner’s Answer, the rejection of Claim 1 under 35 USC §112, 2nd paragraph, was withdrawn. While not stated in the Examiner’s Answer, it is presumed that the Examiner has also withdrawn the objection to the abstract.

The argument set forth on pages 3 and 4 of the Examiner's Answer fails to address the DECLARATION OF MICHAEL L. CLARK UNDER 37 C.F.R. §1.132, mailed to the USPTO on April 26, 2006, in response to the non-final Office Action mailed February 13, 2006. MPEP §716 states:

“It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection.”

On April 2, 2007, the undersigned attorney checked the public PAIR system and confirmed that the DECLARATION OF MICHAEL L. CLARK UNDER 37 C.F.R. §1.132 is in fact part of the file history of the subject application, and further, bears a filing date of May 2, 2006. It is also noted that the DECLARATION OF MICHAEL L. CLARK was argued in Section VII of the Appeal Brief and attached thereto in the evidence appendix.

Pursuant to MPEP §716.01, the DECLARATION OF MICHAEL L. CLARK was submitted timely, since it was submitted prior a final rejection.

The entire basis of the anticipation rejection of Claim 1 over U.S. Patent No. 5,375,768, is predicated on the examiner’s contention that the valve of the sprinkler of ‘768 of Clark satisfies the requirement of Claim 1 that the valve “prevents by selectively re-directing the pressurized fluid around the turbine over-spinning of the turbine when the pressurized fluid is air or a mixture of water and air.” This contention is directly contradicted by the DECLARATION OF MICHAEL L. CLARK in paragraph 8 thereof. Michael L. Clark, being the inventor of the Clark ‘768 patent, is not only an expert in the field of the design of sprinklers, but furthermore, he is the person that is the most knowledgeable about the structure and operation of the valve in the sprinkler of the ‘768 Clark patent.

On page 4 of the Examiner’s Answer, the examiner continues to fundamentally confuse concepts of “novelty” and “non-obviousness” under U.S. patent law. More particularly, the examiner states:

“Thus, since the valve operates on pressure, the valve would open further to allow fluid to bypass the turbine to prevent over-spinning if the fluid was also air or a combination of air and water and as such, one having ordinary skill in the art could expect a reasonable expectation of success.”

The concept of a “reasonable expectation of success” has no bearing on a determination of novelty whatsoever. It is the second element of the tripartite test for obviousness laid out in the often cited Federal Circuit decision of *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). Moreover, there is no mythical person of ordinary skill in the art involved in a determination of novelty under 35 USC §102.

Accordingly, withdrawal of the rejection of Claim 1 for lack of novelty over the ‘768 patent of Clark is requested.

Respectfully submitted,



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